

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on January 24, 2003, and the references cited therewith.

Claim 3 is amended. Claims 44-51 have been added. As a result, claims 1, 3-6, 32-34 and 36-51 are now pending in this application. Support for the new claims is found at least on page 4, lines 26-30, making reference to "80%", and page 5, line 28, making reference to "exhaust holes 52".

The specification has been amended to correct a typographical error.

Drawing Fig. 3 has been amended to renumber the first-occurring element 52 as 50. A complete set of the formal drawings, including currently amended Fig. 3, is attached hereto.

§102 Rejection of the Claims

Claims 1, 3-6, 32-34 and 36-41 were rejected under 35 USC § 102(e) as being anticipated by Behl (U.S. 6,185,097 B1). This rejection is respectfully traversed. Applicant reserves the right to swear behind the reference at a later date. However, the MPEP requires that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131. Because the Applicants assert that Behl does not disclose the identical invention claimed, this rejection is respectfully traversed.

Claim 1 of the application references "at least one board suitable for accepting a plurality of components including a first component" and "an isolation assembly for generally enclosing heat generated from the first component". In contrast, Behl describes an assembly that "includes a memory storage device" Col. 1, lines 27-28. The memory storage device is referred to as a hard disk drive at Col. 1, lines 18-19. No teaching is found of a component mounted on a board as claimed. Since Behl lacks at least one element of claim 1, the rejection should be withdrawn.

Claims 3-6 are dependent on claim 1 and thus distinguish the references for at least the same reasons. Claim 3 has been amended to indicate that the conduit is "separate from the first and second fans" to more clearly describe the structure. Claim 4 describes a heat sink operably coupled to the first component. Since the component in claim 1 is accepted on a board, and no such board is taught or described, claim 4 further distinguishes the invention from Behl. Claim 5 references multiple components on the board in the isolation assembly. Only a single memory

device is within each device bay of Behl. Claim 6 further specifies a plurality of components, and that air is drawn within the case. Neither of these are found in Behl. As the office action admits, Behl describes that "air is drawn from outside (22, fig. 1)", not from within as claimed in claim 6.

Claims 32-33 are dependent on claim 1 and thus distinguish the references for at least the same reasons.

Claim 34, and claims 36-41 that are dependent on claim 34, also reference a "board suitable for accepting a plurality of components including a first component" As each of the pending claims contain elements now shown or inherent in Behl, a *prima facie* case of anticipation has not been established and the rejection should be withdrawn.

§103 Rejection of the Claims

Claims 42 and 43 were rejected under 35 USC § 103(a) as being unpatentable over Behl in view of Papa et al. (U.S.6,175,490 B1). This rejection is respectfully traversed.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

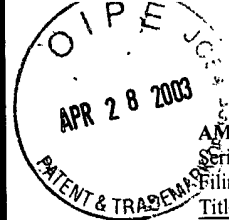
In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

While it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d (BNA) 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202

U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979)). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which indicates that the motivation must be supported by evidence in the record.

Claim 34, from which claims 42 and 43 depend has been show allowable over the Behl as previously discussed. Papa et al. is not cited as providing the elements missing from Behl. Since the combination of references do not show each and every element of claim 34, arranged as arranged in claim 34, a *prima facie* case of obviousness has not been established. It is respectfully requested that the rejection be withdrawn. Further, the suggestion to combine must be found in the art. The statement that it would have been obvious "since processors are heat-generating sources." is merely a subjective statement of belief, and insufficient to support the combination. In fact, the only mention of cooling found by Applicant in Papa et al. is with reference to "sets of perforations 177 in such patterns and numbers to provide effective cooling of the internal components of the chassis 170" Col. 5, lines 1-3, reference to cooling power modules 105, Col. 6 lines 10-12, and references to cooling network interface cards as shown in FIG. 6. There was no mention of heat generated by a CPU, and hence no suggestion to combine Behl and Papa et al.

New claims 44-51 depend from either claim 1 or claim 34, which are believed allowable. As such the new claims are also allowable.



AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 10/034,110
Filing Date: December 26, 2001
Title: CPU FAN ASSEMBLY

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Dkt: 450.232US2

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6972) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.


Respectfully submitted,

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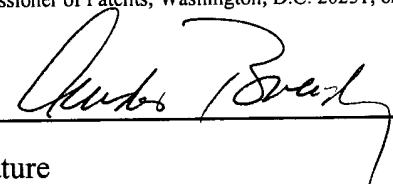
Date 4-22-2003

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 22 day of April, 2003.

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